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ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 NORTH SEVENTEENTH STREET
SUITE 1800
ARLINGTON, VA 22209-9889

EXAMINER

FOX, BRYAN J

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 07/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/932,112

Applicant(s)

YAMADERA ET AL.

Examiner

Bryan J Fox

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group II in the reply filed on 6/14/04 is acknowledged.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 31. Corrected drawing sheets, or amendment to the specification to add the reference character(s) in the description, are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The abstract of the disclosure is objected to because it is two paragraphs long. Correction is required. See MPEP § 608.01(b).

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Pocket Telephone User Interface Featuring
Enlarging and Displaying Additional Information of Selected Icon.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

There are a number of 35 U.S.C. 112, second paragraph issues, including the following:

Claims 8, 10, 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 8, the phrases "such as" and "etc." render the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claim 10, the phrases "such as" and "etc." render the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 10 recites the limitation "said create main screen" in line 24. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "said create new mail screen" in line 28. There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites the limitation "said create new mail screen" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ishigaki (US 20010029193A1) in view of Fujiwara et al (US006540365B1).

Regarding claim 2, Ishigaki discloses a portable telephone system where if a power key 12 is operated, the portable telephone enters a standby mode and displays the five icons as shown in figure 3 on the display section 4 (see page 2, paragraph 35), and the standby mode screen can be chosen by the user (see page 3, paragraph 52). As can be seen in the standby screen in figure 3, the icons are superposed over the screen. Ishigaki also discloses screens that are displayed in response to user inputs (see paragraphs 36 and 37 and figures 4a and 4b). Ishigaki fails to expressly disclose that the screens are superposed over the standby screen.

Fujiwara et al discloses a system where a menu screen is superposed over a background image (see column 7, lines 30-36 and figure 6A).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Ishigaki with Fujiwara et al to include the above superposing of a menu screen in order to provide visual appeasement.

Regarding claim 3, the combination of Ishigaki and Fujiwara et al portable telephone with an icon screen (see Ishigaki figure 3 and paragraph 34), which reads on the claimed "main menu screen where a plurality of icons are shown, arranged in an array, corresponding to items or groups of items from which to choose". If the user selects the icon screen "SCREEN" in the mode, the selected icon is scaled up on the display (see Ishigaki figure 4A and paragraph 36). The selecting of an icon reads on the claimed "one of the icons is chosen and a focus is positioned on it". The selected icon being scaled up reads on the claimed "it is shown enlarged". As can be seen in Ishigaki figure 8A, the enlarged icon partially overlaps the other icons, which reads on the claimed "icons other than the focal icon shift, thus providing space for widening the area where the focal icon is shown".

The only difference between the claimed invention as specified in claim 3 and the disclosed invention is that in the claimed invention the remaining icons other than the focal icon shifted, whereas in the disclosed invention, only the other icons in the immediate vicinity of the selected icon shift. This difference is not critical to the invention, however, and would not render the claimed invention patentable over the disclosed invention because both allow for the enlarging of a selected icon while the

remaining icons are still visible to the user thus providing the same utility to the user. Therefore it would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Ishigaki and Fujiwara et al such that all of the icons other than the one selected shift to accommodate the enlarging of the selected icon.

Regarding claim 4, the combination of Ishigaki and Fujiwara et al portable telephone with an icon screen (see Ishigaki figure 3 and paragraph 34), which reads on the claimed "main menu screen where a plurality of icons are shown, arranged in an array, corresponding to items or groups of items from which to choose". If the user selects the icon screen "SCREEN" in the mode, the selected icon is scaled up on the display (see Ishigaki figure 4A and paragraph 36). The selecting of an icon reads on the claimed "one of the icons is chosen and a focus is positioned on it". The selected icon being scaled up reads on the claimed "it is shown enlarged". As can be seen in Ishigaki figure 8A, the enlarged icon partially overlaps the other icons, which reads on the claimed "icons other than the focal icon shift with their size being downscaled, thus providing space for widening the area where the focal icon is shown".

The only difference between the claimed invention as specified in claim 3 and the disclosed invention is that in the claimed invention the remaining icons other than the focal icon shift with their size being downscaled, whereas in the disclosed invention, only the other icons in the immediate vicinity of the selected icon shift with their size being downscaled. This difference is not critical to the invention, however, and would not render the claimed invention patentable over the disclosed invention because both

allow for the enlarging of a selected icon while the remaining icons are still visible to the user thus providing the same utility to the user. Therefore it would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Ishigaki and Fujiwara et al such that all of the icons other than the one selected shift to accommodate the enlarging of the selected icon.

Claims 5, 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishigaki in view of Fujiwara et al as applied to claims 2 and 3 above, and further in view of Blanchard et al (US006415164B1).

Regarding claim 5, the combination of Ishigaki and Fujiwara et al discloses a system where when an icon is selected and the determination key is pressed (see Ishigaki paragraph 36), which reads on the claimed "choosing one of the icons of the items or groups of items from which to choose displayed on said main menu screen", another screen is displayed where the user may select a function (see Ishigaki paragraph 37 and figure 4B), which reads on the claimed invention that displays on the selecting function screen particular items under the thus chosen item. The combination of Ishigaki and Fujiwara fails to expressly disclose that the icon of the selected screen will be displayed as well.

Blanchard et al discloses an interface for a telephone terminal where the selected icon, as well as the items under the icon, is displayed (see figure 3).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Ishigaki and Fujiwara et al to include the above displaying of the selected icon as well as the items under it in order to provide an

arrangement for presenting various types of user information on a small display that is more flexible in organizing and presenting information than existing arrangements as suggested by Blanchard et al (see column 1, lines 52-57).

Regarding claim 6, the combination of Ishigaki, Fujiwara et al and Blanchard et al discloses a system where when an icon is selected and the determination key is pressed (see Ishigaki paragraph 36), which reads on the claimed "choosing one of the icons of the items or groups of items from which to choose displayed on said main menu screen", another screen is displayed where the user may select a function (see Ishigaki paragraph 37 and figure 4B), which reads on the claimed invention that displays on the selecting function screen particular items under the thus chosen item. In addition, the selected icon, as well as the items under the icon, is displayed (see Blanchard et al figure 3).

Regarding claim 13, the combination of Ishigaki and Fujiwara et al discloses a main menu screen with a plurality of icons shown and one of the icons selected (see Ishigaki figure 4A). The combination of Ishigaki and Fujiwara et al fails to disclose that the icons will be in a single row.

Blanchard et al discloses an interface for a telephone terminal where main menu icons are displayed in a single row at the top of the display (see figure 3). The items under a main icon are displayed in a list when that icon is selected while all the main icons remain visible (see figure 3).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Ishigaki and Fujiwara et al to include the

above displaying of the icons in a single row as well as the items under it in order to provide an arrangement for presenting various types of user information on a small display that is more flexible in organizing and presenting information than existing arrangements as suggested by Blanchard et al (see column 1, lines 52-57).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ishigaki in view of Fujiwara et al as applied to claim 2 above, and further in view of Singh (US006389278B1).

Regarding claim 7, the combination of Ishigaki and Fujiwara et al fails to expressly disclose a list of contacts.

Singh discloses a wireless communicator with a plurality of cards of people that could be contacted may be displayed (see column 5, lines 3-6), which reads on the claimed "address book screen where a plurality of name entries of persons or parties whom the user of said pocket telephone has contacted or may contact are displayed in a list", and for the selected card, additional information is displayed (see figure 5), which reads on the claimed "for the focal entry, its detailed information about the address book as well as the name of the person or party being displayed".

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ishigaki in view of Fujiwara et al as applied to claim 2 above, and further in view of Castell et al (US 20020098831A1).

Regarding claim 8, the combination of Ishigaki and Fujiwara et al fails to expressly disclose a list of people contacted.

Castell et al discloses a unified event listing that is a reflection of such events as e-mail messages received, faxed received, voice mail messages, outgoing e-mail messages and telephone call logs (see paragraph 35), which reads on the claimed "record screen where a plurality of name entries of persons or parties whom the user of said pocket telephone has contacted are displayed in a list". In a preferred embodiment, the information elements includes a graphical icon (see paragraph 35) and as can be seen from figures 2 and 3, the icon relates to the type of contact, for example, an envelope for a message, phone for a call, etc, which reads on the claimed "icon to indicate the type of contact means taken at the last contact being attached to each name entry". For all the entries the time of contact, name and further information is displayed (see figures 2 and 3 and paragraph 35), which reads on the claimed "for the focal entry, its record information such as last contact date/time, the number of times of contacts, etc. as well as the name of the person or party being displayed".

Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishigaki in view of Fujiwara et al as applied to claim 2 above, and further in view of Beaton et al (US006608637B1) and Wolff et al (US005774887A).

Regarding claim 9, the combination of Ishigaki and Fujiwara et al fails to expressly disclose a compose mail screen.

Beaton et al discloses a user interface for a telecommunications device where by pressing a button the user automatically sets up an SMS message (see column 6, lines 57-67 and figures 8B and 8C).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Ishigaki and Fujiwara et al to include the above interface for composing a message in order to provide a simple interaction model by which a user can select and operate multiple communication tasks concurrently as suggested by Beaton et al (see column 7, lines 22-25). The combination of Ishigaki, Fujiwara et al and Beaton et al suggests some help or information available in the compose mail interface with the "i" icon (see Beaton et al figure 8C), however, it fails to expressly disclose a help icon assigned to each input field.

Wolff et al discloses an interface where each field may have an associated help icon that the user may select (see column 9, lines 5-36).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Ishigaki, Fujiwara et al and Beaton et al with Wolff et al to include the above help icons associated with each input field in order to present a user with an interface that is intuitive to complete and easy to follow and efficient as suggested by Wolff et al (see column 2, lines 21-34).

Regarding claim 10, the combination of Ishigaki, Fujiwara et al, Beaton et al and Wolff et al discloses a compose mail screen with the user's telephone number (see Beaton et al figure 8C), which reads on the claimed "functional information about their pocket telephone model or other communications equipment, such as the maximum number of characters displayable, displayable file formats, etc. is stored in memory so that the user can refer to the functional information when entering mail text at said create main screen".

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Ishigaki, Fujiwara et al, Beaton et al and Wolff et al as applied to claims 9 and 10 above, and further in view of Jambhekar et al (US006430405B1).

Regarding claims 11 and 12, the combination of Ishigaki, Fujiwara et al, Baton et al and Wolff et al discloses a system where when a user composes an SMS message, it can be one of three types: an SMS text message, an SMS ink message, or an SMS text message with hypertext markup language code (see Beaton et al column 6, lines 64-67). The combination of Ishigaki, Fujiwara et al, Beaton et al and Wolff et al fails to expressly disclose a list of icons to determine the message type.

Jambhekar et al discloses a mobile phone interface where a user is presented with a number of icons to choose the message type (see, for example, figure 10-7).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Ishigaki, Fujiwara et al, Beaton et al and Wolff et al with Jambhekar et al to include the above presentation of icons to choose a message type in order to provide more convenient operation by the user as suggested by Jambhekar et al (see column 1, lines 52-56).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ishigaki (US20010022839A1) discloses a method for changing scroll mode in portable telephone and portable telephone using said method.

Ishigaki (US20010046886A1) discloses an e-mail handling method for portable telephone and potable telephone using said handling method.

Heikkinen et al (US006073036A) discloses a mobile station with touch input having automatic symbol magnification function.

Karkkainen et al (US006600936B1) discloses a terminal for wireless telecommunication and method for displaying icons on a display of such a terminal.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan J Fox whose telephone number is (703) 305-8994. The examiner can normally be reached on Monday through Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BJF


LESTER G. KINCAID
PRIMARY EXAMINER